

REMARKS

The present Amendment amends claim 1, leaves claims 2-10 unchanged and adds new claims 11-18. Therefore, the present application has pending claims 1-18.

In the outstanding Office Action the Examiner identifies a total of forty (40) alleged distinct species and requests Applicants to elect one of the alleged species and to identify claims which read on the elected alleged species for further prosecution on the merits.

In response to the restriction requirement, Applicants hereby elect with traverse alleged Species 1, Figs. 2a-b upon which claim 1 and all of the its dependent claims 2-10 read for further prosecution on the merits. Further, new claims 11-18 are directed to the elected alleged Species 1, Figs. 2a-b and therefore should be examined with claims 1-10 directed to the elected alleged species.

It should be noted that dependent claims 2-10 each depend from claim 1 and therefore include the same features for patentability as set forth in claim 1. The same can be said for dependent claims 12-18 each of which depends from independent claim 11. These dependent claims 12-18 each depending on claim 11 and claims 2-10 each depending from claim 1 are in effect linking claims which link the elected invention to the non-elected inventions and thus cannot be separate from their independent claims since each specifically recite its dependency on the independent claims. Therefore, examination should proceed based on claims 1-18.

Further, it should be noted that Species 1, Figs. 2a-b and claim 1 are generic to Applicants invention since the invention is directed to a pointing device for moving a pointer on a display screen having a transparent plate 4a, image detecting means

4c for detecting an image of the surface of an object 7 that contacts the outer surface of the transparent plate 4a, an optical means 4d for forming an image of the outer surface of the plate on a detection plane of the image detecting means 4c. These elements recited in claim 1 and as illustrated in Fig. 2a are common through various ones of the alleged species specifically Species 2-18 and Species 37-40. For example, as illustrated in Species 2 and 3, Figs. 3a and 3b respectively a transparent plate 4a is provided along with an image forming means 4d and an image detecting means 4c. Thus, Applicants submit that Species 1, Figs. 2a-b is generic relative to Species 2-18 and Species 37-40. Therefore, the Examiner is respectfully requested to acknowledge that Species 1 is generic to at least Species 2-18 and 37-40.

With respect to the traversal the following is provided.

Applicants have reviewed each of the paragraphs in the Office Action and have determined that at no point did the Examiner indicate why restriction is deemed appropriate. The Examiner's attention is directed to the requirements for restriction which must include a showing that two or more inventions are in fact independent and distinct as set forth MPEP 806.04 through 806.04(i). There are several grounds identified for holding that restriction to a single elected species is necessary. For example, different sub-combinations usable together in a single combination, product and process inventions, etc. At no point in the Office Action has the Examiner made any such allegation. Therefore, the Examiner has not made a *prima facie* case that restriction is necessary.

Further, it appears that the Examiner merely identifies numerous figures which may illustrate sub-features of the invention as being a different species. For example, Figs. 2a through 4b are directed to the pointing device of the present invention and the various elements included within the pointing device (transparent plate 4a, image detecting means 4c and optical means 4d), whereas Figs. 5a-f merely illustrate various details which may improve the operation of the transparent plate 4a. Thus, Figs. 5a-f simply illustrate the details of sub-features of the invention which do not rise to the level of a species as alleged by the Examiner.

Thus, it appears that the Examiner is completely confused as to the requirements of a species and has simply identified all of the figures of the present application as illustrating a different species. Such is certainly not the case and the specification is clear on this point.

Therefore, based on the above it is quite clear that the Examiner has not made a *prima facie* case that restriction to a single elected species is necessary. Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (500.40519X00).

Respectfully submitted,

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